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IN THE

Supreme Court of the United States

October Term, 1972.

No. 72-294.

L. GOLDSTEIN'S SONS, INC.,
Petitioner,

v.

TRIO PROCESS CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Third Circuit.

BRIEF OF RESPONDENT TRIO PROCESS CORPORATION OPPOSING MOTION OF FORD MOTOR COMPANY FOR LEAVE TO FILE A BRIEF AMICUS CURIAE.

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October 9, 1972.

Huntzinger Printing Corp., *Appellate Printers*, Camden, N. J.

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Ford Motor Company seeks leave to file a brief *amicus curiae* because of its involvement in a copending patent suit which, according to Ford's contentions, involves a related issue. Respondent opposes the filing of such a brief.

In *Ellipse Corporation v. Ford Motor Co.*, 452 F. 2d 163, 167-170 (7th Cir., 1970), the Court of Appeals affirmed the District Court's holding that claim 3 of Ellipse's patent number 2,628,568 to Rhine is valid and infringed by the balanced slipper pumps used in Ford's automobile power

steering system. Ford unsuccessfully petitioned for a writ of *certiorari* (—— U. S. ——, 92 S. Ct. 2041).

Ford now comes to this Court in dual postures. First, in is own case, Ford urges the Court to reconsider its denial of Ford's petition for writ of *certiorari*, again arguing "file wrapper estoppel", and urging that the present case demonstrates a need for resolution of a matter on which it repeats its contention that the different Circuit Courts of Appeals are divided. Second, Ford asks leave to interpose a brief *amicus curiae* in the present case.

Ford's motion for leave to file an *amicus* brief should be denied because: (1) Ford does not have a genuine interest in any matter at issue in the present case, and (2) an additional brief, filed in the present case without full knowledge of the factual background, is more likely to be distractive than helpful.

Ford Does Not Have a Genuine Interest In Any Matter At Issue In This Case.

The proposition which Ford urges as being identically presented in the first question of Goldstein's petition in the present case and the first question in Ford's petition in the *Ellipse* case is not properly presented for determination in either of the two cases, much less identically presented in both.

In *Ellipse v. Ford*, what the Rhine '568 patent shows and describes is a balanced slipper pump having an elliptical stator cavity (see appendix to Ford's Petition for a Writ of Certiorari in *Ford Motor Co. v. Ellipse Corp.*, No. 71-1147, filed in March, 1972, A59-A70). Ford uses such a balanced slipper pump with an elliptical stator cavity. Claim 3 of Ellipse's Rhine patent clearly is literally infringed by Ford's balanced slipper pump. Ford attempts to escape liability on the ground that when the Rhine application for the '568

patent was pending, the claim which ultimately became claim 3 of the patent was so greatly broadened by the rewording from "elliptical stator cavity" to "out-of-round stator cavity" as to render the resultant claim 3 of the patent invalid because of anticipation by certain **unbalanced** pumps with asymmetrical cavities quite different from elliptical cavities. The Seventh Circuit Court of Appeals concluded that that change of the claim wording only **slightly** broadened the scope of the claim to cover a pump with elliptical **or equivalent** stator cavity, whereby a pump with an approximately elliptical cavity would be a literal infringement. The Court of Appeals did not avoid relying on the Rhine file wrapper to determine how much the claim had been broadened—quite the contrary.* The Court did indeed consider the impact of the change of wording as introduced in the claim by amendment, as well as the remarks concerning that change. Thus, the Court noted that the Rhine file wrapper "refers to the limitation in the original claim that the stator be 'elliptical' as being only 'somewhat broadened' by the added term 'out-of-round.'" (452 F. 2d at 168).

Despite these facts, in straining to present a basis which might appear to appeal to this Court's interest in giving aid and guidance to the courts below toward uniformity of application of legal principles, Ford glosses over the fact that the Seventh Circuit Court of Appeals did indeed take into account fully Rhine's file wrapper in determining how claim 3 of Rhine's patent should be construed, and found it to be **slightly** broadened, unanticipated by the prior art, and literally infringed by Ford's balanced slipper pumps with their elliptical stator cavities. Ford had to overlook that fact,

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* The Seventh Circuit Court of Appeals, notwithstanding its comments on the holdings of various prior cases concerning the conditions under which file wrapper estoppel arises, did not by any means rule out consideration of the changed scope of Rhine's claim, or the comments concerning it, on the ground that that change did not result from rejection of the claim on the prior art (or on any other ground).

since otherwise it hardly could have urged this Court to consider taking the position that the Court below had erred in refusing to proceed in accordance with, and be governed by, the changes of claim wording and explanatory remarks set forth in the file wrapper.*

The present case also fails to present for determination, as a controlling issue, the question whether the narrowing (or the broadening) of a claim during prosecution of the patent application for reasons other than overcoming a rejection on prior art, constitutes estoppel. In the present case there are three claims in suit (claims 1, 3 and 4), of which the first claim is literally infringed by the defendant-petitioner Goldstein's, the doctrine of equivalents being invoked for the other two claims in suit (claims 3 and 4). Goldstein's urged the Court of Appeals to deny respondent Trio the benefit of the doctrine of equivalents on the ground that a file wrapper estoppel had arisen in the prosecution of Spitz's application for the wire reclamation process patent in suit. Here, as in the *Ford* case, attention was indeed given by the Court to the file wrapper to ascertain whether it showed circumstances which would

> ". . . estop a patentee from taking a position as to the meaning of claims when asserting them during litigation inconsistent with the position he had taken before the Patent office when obtaining them?"**

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* What this really leaves for Ford to urge upon this Court with respect to **Ellipse v. Ford**, is that the Supreme Court make itself available for one more stage of appellate review so that Ford may try to persuade this Court to take into account the Rhine file wrapper (the lower courts already having taken it into account) but somehow to come to a conclusion as to the issue of validity of claim 3 opposite to to that reached by both the Courts below on the same facts.

** This quoted portion is Ford's phrasing which appears on page 3 of its Supplemental Brief in Support of Petitioner's Petition for Rehearing of Denial of Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit, filed on or about September 22, 1972, a brief purportedly deriving justification under Supreme Court Rule 58(2) from the recent emergence of the decision in **Trio v. Goldstein's**, and urging the Court to grant writs of certiorari in both cases.

But for its lack of familiarity with all the facts of the present case, Ford might well have recognized the futility of trying to lean on this case for any help. To do so is clutching at straws. What the Court of Appeals found upon scrutiny of the Spitz file wrapper was that the Examiner, in accordance with a technical rule of the Patent Office, had refused to permit the applicant to insert in his application claims 16 and 17 (as initially worded) which the Examiner deemed to deviate in one respect from the order of steps delineated in the specification. Patent Office Rule 75(d), providing that "The claim or claims must conform to the invention as set forth in the remainder of the specification . . . ", made it incumbent on the Examiner to proceed as he did. The two claims refused on that technical rule were amended to provide unquestionable conformity to the explicitly described illustrative "embodiment" of the invention, and eventually issued as claims 3 and 4 of the patent.

The initial versions of application claims 16 and 17, which were not includable according to the Patent Office's technical rule, were not anticipated by the prior art. Neither were they narrowed down (or broadened) to meet definiteness requirements. They were refused only because the doctrine of equivalents, which does come into effect in an infringement suit to defeat piracy by others, does not confer upon an applicant the right to insert claims specific to obvious equivalents to the embodiment he describes in his specification—equivalents which would infringe in any event under the doctrine. *In re Key*, 76 F. 2d 398, 400 (C. C. P. A., 1935); *Bryson v. Clarke*, 92 F. 2d 720, 724-25 (C. C. P. A., 1937).

In the litigation against petitioner Goldstein's, Spitz thus takes no position as to the meaning of even claims 3 and 4 of his patent which would be, in Ford's words, ". . . inconsistent with the position he had taken before the Patent Office when obtaining them." He takes the same position in the litigation as he took then—that (1) he must comply

with the Patent Office's technical rules, and (2) under the applicable law, he would be entitled to the protection afforded by his patent claims, against a process which is a literal infringement of any claim whose terms are met (claim 1), and against a process which, if not a literal infringement of certain claims (claims 3 and 4), employs substantially the same combination of steps in substantially the same way to produce the same results. There is no way to reshape the Patent Office's enforcement of its rule 75(d) into a commitment in advance by the applicant that his patent shall be deprived of the law's normal protection afforded patentees under the doctrine of equivalents.

An Additional Brief by a Non-Party Lacking Thorough Familiarity with This Case Would be Distractive—Not Helpful.

What the movant Ford proposes to argue in an *amicus curiae* brief is that this case presents for resolution an unsettled question troubling the Circuit Courts of Appeals. But as shown above, the question posed by Ford really is not presented for determination in this case. Furthermore, the attempts to show diversity of views on the conditions for file wrapper estoppel among the various Circuit Courts of Appeals depend mainly on *obiter dictum*, rather than any showing of cases where application of different rules of law produced irreconcilable results. In *Borg-Warner Corp. v. Paragon Gear Works, Inc.*, 355 F. 2d 400, 405-06 (1st Cir., 1965), cert. dismissed 384 U. S. 935 (1966), the First Circuit Court of Appeals compared cases containing statements to the effect that the presence or absence of a rejection on prior art is a criterion for file wrapper estoppel with other cases which seem to differ as to the criteria, and concluded that in reality, the cases do not show substantial variation.

As the Court there observed, "Actually, we believe there is no real conflict, except linguistic."

The greatest variations among the cases which refer to "file wrapper estoppel", or deal with related principles, are the variations in the facts presented. In the last analysis, each case must be decided on its facts. And when the facts as well as the Court's conclusions are taken into account, one finds substantial consistency among the applications of the principle of file wrapper estoppel, not only within a given circuit but among the different circuits. Respondent Trio submits that Ford's attempted injection of itself into this case to urge a contrary view to try to benefit its own case is neither needed nor justified, and hence its motion should be denied.

Respectfully submitted,

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